

REMARKS

The above-identified Office Action dated January 2, 2004, contained a final rejection of claims 13-15, 17-19, 22-24, 26-28, 31-33, 35-37, 40-42, and 44-49. Claims 10, 19, 28, 37, 46 and 48-49 have been amended in this amendment in an effort to **clarify the invention**. Therefore, the Applicants submit that a new search will **not** be required by the Examiner. As such, the foregoing amendments to the claims and the remarks below are intended to place the case in condition for allowance, or alternately in better form for consideration on appeal under 37 CFR 1.116. Therefore, it is respectfully requested that the amendments to claims 46 and 48-49 be entered despite the finality of the present rejection.

The Office Action rejected claims 10, 17-19, 26-28, 35-37, 44-49 under 35 U.S.C. § 103(a) as being unpatentable over Dasan (U.S. Patent No. 5,761,662) and Hoyle (U.S. Patent No. 6,141,010) in view of Ellis et al. (U.S. Patent Publication No. 2003/0020744). Next, the Office Action rejected claims 13-14, 22-23, 31-32 and 40-41 under 35 U.S.C. § 103(a) as being unpatentable over Dasan (U.S. Patent No. 5,761,662) and Hoyle (U.S. Patent No. 6,141,010) and Ellis et al. (U.S. Patent Publication No. 2003/0020744) in view of Guyot et al. (U.S. Patent No. 6,119,098). Last, the Office Action rejected claims 15, 24, 33 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Dasan (U.S. Patent No. 5,761,662) and Ellis et al. (U.S. Patent Publication No. 2003/0020744) in view of Headerick et al. (U.S. Patent No. 6,557,006).

The Applicants respectfully traverse these rejections based on the arguments below. If one of the elements of the Applicant's invention is missing from or not taught in the cited references and the Applicant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. In Re Evanega, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987). In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.

Specifically, the cited references, when combined, are missing the Applicant's claimed element of "...transmitting at least a portion of the reader profile information for display to the reader, wherein the reader profile information includes one or more type

of denied data that is transmitted to the reader for display ...” Although the Examiner argued that Dasan teaches “receiving a display of profile information...” and Ellis et al. teaches “...profile information includes one or more types of denied data...”, clearly, the combined references do **not**, disclose, teach or suggest the Applicant’s claimed “...transmitting at least a portion of the reader profile information for display to the reader, wherein the reader profile information includes one or more type of denied data that is transmitted to the reader for display...”

Instead, Dasan simply discloses the ability to display general information and topics found related to the user’s profile (see col. 7, lines 52-54, col. 8, lines 26-40 and FIG. 11 of Dasan), but **not** denied data profile information that is transmitted to the reader for display, like the Applicant’s claimed invention. In addition, Ellis et al. merely discloses allowing a user to define preference “...levels that may be used to indicate the user’s interest or disinterest in a given preference attribute.” (see paragraphs 90 and 94 of Ellis et al.). However, unlike the Applicant’s claimed invention, these “disinterested” or “illegal” preferences in Ellis et al. are **not** transmitted for display to the reader. Hence, the combination of Dasan with Ellis et al. does **not** disclose all of the elements of the Applicants’ claims, and thus, **cannot** render the Applicants’ invention obvious. In Re Evanega.

Even though the combination of the cited references **does not** produce all of the elements of the claimed invention, these references **should not** even be considered together since there is no motivation to combine the cited references. It is well-settled law that there **must be** a basis in the references for combining or modifying the references. The Examiner **cannot** arbitrarily “pick and choose” elements from numerous references and combine these elements without some basis.

Specifically, certain elements of the Applicant’s invention, such as “denied data”, “second content”, “voluntary profile information” and “behavior profile information,” were arbitrarily taken from numerous references and combined without some basis. According to In re Blamer, Civ. App. No. 93-1108 (Fed. Cir. Sept. 21, 1993), it is improper for an Examiner to cite a number of references variously containing some of the limitations in the applicant’s claims and combine them in a piecemeal fashion without any suggestion or motivation for their combination and without regard to the purpose of the applicant’s

invention. Where the Examiner has relied on the teaching of several references, the test is whether or not the references viewed individually and collectively would have suggested the claimed invention. For example, the ruling in Ex parte Hiyamizu, 10 USPQ2d 1393 (1998) makes it clear that the citing of references which merely indicated isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious.

In addition, the "...combination of elements...in a manner that reconstructs the applicant's invention only with the benefit of hindsight...is insufficient to present a prima facie case of obviousness." There must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination. **That knowledge cannot come from the applicant's invention itself.** In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) [emphasis added].

Further, "[T]he genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references." Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the reference in question seems relatively similar "...the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously." McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [emphasis added]. Therefore, since the Examiner has failed to provide references with all of the Applicant's claimed limitations, the rejection is improper and a prima facie case of obviousness cannot be established. In re Kotzab, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP 2143*.

Last, because the dependent claims depend from the above argued independent claims, and contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable over these references.

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As the foregoing amendments to the claims do not raise new issues, it is the Applicant's position that they are entitled to have the changes entered to place this case in condition for allowance, or alternately, in better condition for consideration on appeal under 37 CFR 1.116. It is, therefore, respectfully requested that the changes to the claims be entered despite the finality of the present rejection.

Thus, it is respectfully requested that the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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